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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/857,495	06/28/2001	Shinichi Yamada	057250903	5364

7590

08/07/2003

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EXAMINER

YU, GINA C

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 08/07/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/857,495

Applicant(s)

YAMADA ET AL.

Examiner

Gina C. Yu

Art Unit

1617

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 09 July 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
(a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ they raise the issue of new matter (see Note below);
(c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See continuation sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See continuation sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: None.

Claim(s) objected to: None.

Claim(s) rejected: 19-81.

Claim(s) withdrawn from consideration: None.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____

REENI PADMANABHAN
PRIMARY EXAMINER

8/7/03

Continuation from No. 2:

The amendment is not entered because examiner views that the claim as proposed would be still subject to rejection under 35 U.S.C. § 112, second paragraph for being vague and indefinite. Claim 55 is rejected as indicated in the Office action dated April 9, 2003 because the claim recites a range within a range. While it appears that applicants are claiming 18-methyleicosanoic acid, which is a specific compound, yet claim 55 recites the term "chosen from" as if applicants are claiming alternative limitations. Thus it is not clear whether a C16-C60 fatty acid is the intended limitation, or 18-methyleicosanoic acid alone is the claimed limitation. Examiner views that the proposed amendment does not overcome this problem. While it appears that the claimed fatty acid is 18-methyleicosanoic acid, a single compound, the proposed claim reads as if there are several types of the fatty acids from which the limitation can be chosen.

Continuation from No. 5:

Request for reconsideration has been fully considered but does not place the application in allowable condition because the arguments are not persuasive. Applicants argue that the rejection is based on improper picking and choosing individual components from isolated disclosures in the cited references. Examiner respectfully disagrees. Bergmann teaches the use of ceramide and phytantriol for hair treatment purposes. Dubief teaches the use of the quaternary ammonium surfactants for hair conditioning effects. The application of these inventions in oxidation compositions such as hair permanent waving product is also taught in both references. Examiner

maintains the position that the references provide object evidences for a routineer in the art to find these compounds useful for same purposes, and that the combination thereof with the Maubru composition would have been obvious.

Applicants also argue that there is no evidence to predict the outcome of a composition or have a reasonable expectation of success for the combination. Examiner notes that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In this case, examiner reiterates that the prima facie obviousness requirement is met because the collective teachings of the prior art references provide motivation for a skilled artisan to combine the ceramide and quaternary ammonium surfactants with the Maubru composition. There is reasonable expectation of success in such combination because all three references are related to hair care compositions and teach the application of the inventions in hair dye and/or permanent wave compositions, which are oxidation compositions.

Applicants further rely on the general teaching in Zviak reference to show the alleged unpredictability in formulating hair dye composition. Examiner notes, however, that applicants fail to provide any specific evidence as to why this specific combination of ceramide and quaternary ammonium surfactants with the Maubru invention would be unpredictable or produce surprising results.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 703-308-3951.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 703-305-1877. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Gina C. Yu
Patent Examiner
August 6, 2003